REMARKS

This Amendment is in response to the Office Action having a mailing date of March 7, 2002. Claims 1-2, 4-30, and 33-34 are amended as shown to more concisely recite what is being claimed. New claims 35-49 are added. No new matter has been added. With this Amendment, claims 1-49 are now pending in the application.

In the Office Action, claims 17-22 and 33 were rejected under 35 U.S.C. § 112, second paragraph, for being indefinite. Independent claims 17 and 20 (and their applicable dependent claims) have been amended to overcome this rejection, and are now allowable under 35 U.S.C. § 112, second paragraph. In the Office Action, claims 1-34 were rejected under 35 U.S.C. § 102(e) as being anticipated by Beck (U.S. Patent No. 6,332,154B2). For reasons set forth below, the Applicants respectfully request the Examiner to reconsider and to allow all pending claims.

A disclosed embodiment of the invention will now be discussed in comparison to the applied reference. Of course, the discussion of the disclosed embodiment, and the discussion of the differences between the disclosed embodiment and subject matter described in the applied reference, do not define the scope or interpretation of any of the claims. Instead, such discussed differences are intended to merely help the Examiner appreciate important claim distinctions discussed thereafter.

One embodiment of the present invention is directed towards use by legal professional (such as lawyers or paralegals) in a legal process called "discovery" (although it is understood that embodiments may be used for other types of legal proceedings). By way of background, "discovery" involves a set of rules and procedures that allows opposing attorneys to obtain evidence from each other's clients. Use of one embodiment of the Applicants' invention in the context of discovery can be illustrated by way of example by reference to Figure X below.
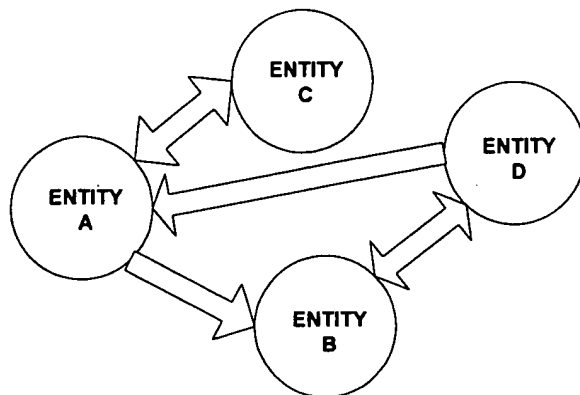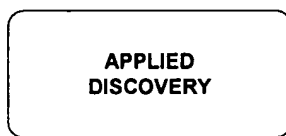
FIGURE X

APPLIED
DISCOVERY

In Figure X, "Applied Discovery" is the assignee of the present application and is involved in the business of providing electronic legal tools to legal professionals, such as the discovery tools/technology described in the present application. Entities A-D can include companies, individuals, or other third party that generally has no direct relationship or interaction with Applied Discovery. The one-way and two-way arrows between Entities A-D illustrate various communication between them, such as email, voicemail, postal mail, etc. In some contexts, this interaction can be between employees in a company (such as email exchanged between employee A and employee C). The third-party electronic files can also include electronic files stored locally by a certain employee (such as task lists, MS Word™ files, spreadsheets, and so forth) in a workstation hard-drive, or can involve "one-way" communications such as saving electronic files into a file server.

Assume next for purposes of this hypothetical that Company KLM (having employees A and C) is sued by Company RST for breach of contract. To build its case and as part of the litigation process, Company RST retains a law firm to prepare and send discovery requests to Company KLM's law firm. Such discovery requests may include, for instance, "Produce all emails and other files internal to Company KLM (board minutes, financial projections, position papers, marketing materials, etc.), or exchanged externally between Company KLM and other entities, dated between July 1, 1999, and September 6, 1999." The

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purpose of this request may be, for instance, to locate evidence as to when Company KLM may have first contemplated breaching the contract with Company RST.

Traditionally then, Company KLM's law firm produces hardcopy printouts of the requested emails (provided to them by Company KLM), and gives the hardcopies to Company RST's lawyers. Then, Company RST's lawyers have to laboriously sort through the voluminous hardcopy printouts to locate relevant emails usable for building their case for breach of contract. A relevant email, for example, might be an email from employee A to employee C saying, "We are losing too much money on this contract with Company RST. Let's look for another vendor." In contrast, non-relevant email between these two employees may be, for example, "Let's meet for lunch and talk about golfing this weekend." Other emails may be completely without context since their electronic threads or metadata were lost when the hardcopy printout of the email was made, such as a reply email that simply says, "Yes, let's do that" (e.g., by reading the email, it is difficult to tell if this email is talking about golf or breaking a contract, which email it was replying to, etc.).

To address this problem of hardcopy printouts that destroy useful electronic characteristics (such as threading information or metadata) of the original native electronic format of the file, one embodiment of Applied Discovery's invention is directed towards processing and providing lawyers with access to these third-party electronic files in a manner that makes use of the electronic files' electronic characteristics. Thus, the law firms and/or their clients provide information systems data (that are subject to discovery) to Applied Discovery (such as via CD or other storage media or other suitable data-transfer technique). This information systems data can include emails, electronic calendars, text and graphics, MS Word™ files, or other types of third-party electronic files that Entities A-D may have exchanged with each other, or kept locally stored (such as in a hard drive or internal electronic file storage system). Once the files are received by Applied Discovery, it applies the various processes disclosed in the present application to identify, store, and process the electronic characteristics of the electronic files so that attorneys can later intelligently review the files.

These electronic files are third-party electronic files relative to Applied Discovery, in that they do not directly involve interaction with Applied Discovery (as clearly depicted in Figure X). Emails, for instance, are communicated between Entities A and C (e.g., they are the

third parties), and are not communications directed at Applied Discovery at all. Rather, Applied Discovery's involvement occurs when such third-party electronic files are provided to it for processing, and then later accessed for review (through Applied Discovery's services) by a law firm—Applied Discovery is not involved in the interaction and communication that originally generated the electronic files. Once processed as disclosed in the present application, the legal professionals can then review these third-party electronic files, sort them, mark "hot" documents, etc., by electronically following the threads, by sorting the emails by date or sender/receiver (or using other metadata), and so on.

Beck, in contrast to what the Applicants have disclosed, is directed towards a completely different implementation and uses completely different technology. Beck is directed towards an area of technology commonly referred to as "customer relationship management" (CRM) or "computer-telephony integration" (CTI), where instead of human customer service agents, automated hardware and software attempt to make customer service inquiries to a business and the corresponding responses more automated. A customer would call into a company having a CRM system (or "multi-media call center" described in Beck), and then be guided through an automated menu until the customer's questions have been answered.

In Beck's system, communications in the form of telephone calls, voicemail, emails, and faxes (exchanged between customers and a business having the Beck call center) are stored in a storage area of the call center. The stored information is then data-mined in the call center for information relevant to the company's business, such as the subject matter that the customer is calling about. The mined data is then placed in a "knowledge base." See, e.g., Figure 3 of Beck and the accompanying description. For non-text based communications (such as voicemail or a live telephone call), the transaction is recorded, and then a text-based version of the transaction is prepared. Relevant data is then mined from the text-based version and stored in the knowledge base. See, e.g., Figure 3 and accompanying description in Beck. The stored data is then used by the call center to enhance the interaction between the business and its customers, by providing better response time and more tailored responses to customer inquiries.

Figure Y illustrates Beck further, and shows that the CTI/CRM system of Beck inherently cannot (and does not) involve processing of third-party electronic files, because the

communication and interaction is directly between customers and the business having the Beck system:
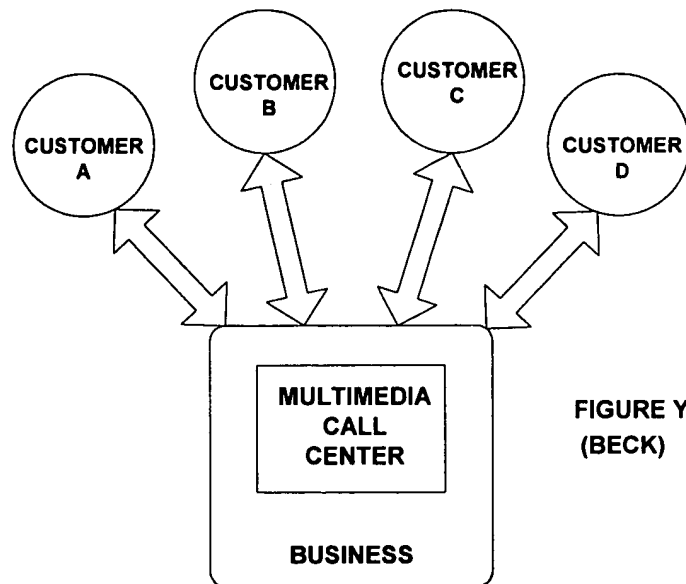

FIGURE Y
(BECK)

Customers A-D interact directly with a business having the multimedia call center of Beck, as illustrated by the two-way arrows in Figure Y. Thus, customer A might exchange an email with a customer service representative of the business, via the call center, to complain about a defective product, for instance. In this case, the email is a first- and second-party communication (e.g., the email is by way of the call center and is directly between the Customer A "first party" and the business "second party," or vice versa).

The technology of Beck is directed to processing this email in the manner disclosed by Beck to improve the interaction between the business and its customers A-D. Therefore, it is noted that Figure X is clearly and significantly different than Figure Y of Beck. Figure X illustrates third-party communication that can be processed by Applied Discovery, and which does not involve direct interaction or communication with Applied Discovery. In comparison, third-party communication is irrelevant to Figure Y and Beck. What is important to Beck is processing the direct communication between customers and the call center so as to provide better customer service. Beck is not interested in and does not disclose the technology to process third-party communication between Customers A-D or other parties with which it has no direct interaction.

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Accordingly, independent claim 1 has been amended to recite third-party electronic files. As described above, this feature is not disclosed, taught, or suggested by Beck, since Beck uses a technique to process direct first- and second-party interactive communications between customers and the call center, and does not process third-party electronic files. Therefore, amended claim 1 is allowable over Beck under 35 U.S.C. § 102(e).

Furthermore, there is no motivation to modify Beck so that it is directed towards third-party electronic files belonging to entities with which it has no involvement. Such a modification will make the Beck System useless because (a) the third-party files would have to be provided to Beck via non-routine methods (*e.g.*, Beck is configured to receive only direct communications specifically sent to its fax connection, email system, telephone numbers, etc.), (b) Beck is not interested in third-party communications unrelated to customer service, and (c) having to provide processing and storage for irrelevant third-party communications will detract from the advantages and enhancements being provided by Beck for efficiently servicing customer inquiries.

For example with email, all incoming emails of Beck arrive in the generic simple mail transfer protocol (SMTP) format, and then changed into the email format used by that business' call center, such as Microsoft Outlook™. This is a simple and conventional process to send and receive email. However, to process emails that were previously exchanged between third-parties, Beck would have to, among other things and if even possible given the system of Beck, install and use possibly dozens of different email application programs or develop their own programs that can read the varied native formats of the emails previously exchanged by the third parties. This is an unnecessary and useless modification for the call center system of Beck because it serves little purpose in enhancing the interaction with inquiring customers.

Claim 9 is a method claim directed towards a method to display electronic files. Claim 9 has been amended to recite that the electronic files are third-party electronic files. As described above, this feature is not disclosed, taught, or suggested by Beck, and therefore amended claim 9 is allowable over Beck.

Claim 13 is a method claim that is directed towards processing electronic files, and has been amended to recite third-party electronic files. Because this feature is not disclosed, taught, or suggested by Beck, amended claim 13 is now allowable.

Claim 17 is a claim directed towards a network node having server communicatively coupled to a database system. Claim 17 has been amended to recite that the electronic files are third-party electronic files.

Independent claim 20 is a system claim that recites a conversion engine in conjunction with a server. Claim 20 has been amended to recite third-party electronic files. This feature is not disclosed, taught, or suggested by Beck, and therefore amended claim 20 is allowable.

Independent claims 23 and 28 are machine-readable medium claims. Claim 23 is amended to recite that the electronic file information is third-party. Claim 28 is amended to recite third-party electronic files. Amended claims 23 and 28 are allowable.

The various dependent claims are amended as shown to make their language consistent with the amended base independent claims. The term "legal documents" has been replaced in many of the claims with -- files -- to clarify that various embodiments of the Applicant's invention have application towards electronic calendar data, task lists, graphics, text, and so forth, which some persons may not readily associate as being a "document" of a legal nature. Dependent claim 21 is amended to positively recite structure. New dependent claims 35-42 and 46-49 are added to recite subject matter supported by the Applicants' disclosure. New independent claim 43 and its corresponding dependent claims recite subject matter that is allowable over the references of record.

Overall, none of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, given the above amendments and accompanying remarks, the independent claims are now in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 622-4900.
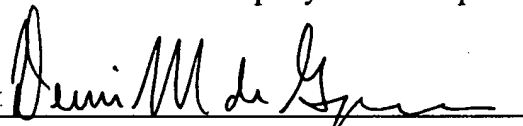
A fee check to cover payment for the additional claims is included with this Amendment. A petition for a 2-month extension along with the applicable fee is also included. It is requested that an initialed copy of Form PTO-1449 for the Information Disclosure Statement filed on June 4, 2002 be returned with the next correspondence from the U.S. Patent Office, to indicate that the Examiner has considered the references listed therein.

Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned "**Version With Markings to Show Changes Made.**"

Respectfully submitted,

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Enclosure:
    Postcard
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    Petition for 2-month extension (and fee)

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In the Claims:

Claims 1-2, 4-30, and 33-34 have been amended as follows:

1.   (Amended) A method, comprising:

storing third-party electronic ~~legal documents~~ files in a database system, including storing and indexing electronic characteristics associated with a native format of the electronic ~~legal documents~~ files;

providing access to the stored electronic ~~legal documents~~ files to a user terminal via a server communicatively coupled to the database system and to the user terminal; and

if user-input information sent from the user terminal to the server is received, processing the indexed electronic ~~legal documents~~ files according to the received user-input information in a manner that allows the processing to use the stored electronic characteristics of the electronic ~~legal documents~~ files.

2.   (Amended) The method of claim 1 wherein the electronic ~~legal documents~~ files comprise email messages having metadata including threading information and wherein storing electronic characteristics associated with the native format comprises storing the threading information.

4.   (Amended) The method of claim 1 wherein storing the third-party electronic ~~legal documents~~ files in the database system, including storing and indexing the electronic characteristics associated with the native format of the electronic ~~legal documents~~ files comprises:

recursively extracting a plurality of third-party electronic ~~legal documents provided from a source~~ files;

identifying a plurality of objects having different data formats for each of the extracted electronic ~~legal documents~~ files, one of the identified objects corresponding to the electronic characteristics;

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storing data associated with the one of the identified objects in a first location in the database system;

converting the other identified objects and storing data associated with the converted objects in a second location in the database system; and

indexing the data stored in the first and second locations.

5.   (Amended) The method of claim 1 wherein storing the~~ third-party~~ electronic ~~legal documents~~files comprises:

storing data associated with text content of the electronic ~~legal documents~~files in a first server unit; and

storing data associated with metadata content of the electronic ~~legal documents~~files in a second server unit having a database.

6.   (Amended) The method of claim 1, further comprising providing a user interface at the user terminal, the user interface comprising a field to enter search query information and a display to display processing summary information associated with the electronic ~~legal documents~~files stored in the database system.

7.   (Amended) The method of claim 1 wherein processing the indexed electronic ~~legal documents~~files comprises:

selecting one of the stored electronic ~~legal documents~~files based on the user-input information

transmitting a copy of the selected electronic ~~legal document~~file for display at the user terminal;

receiving from the user terminal processing summary information associated with the displayed electronic ~~legal document~~file; and

storing the processing summary information in the database system to allow the processing information and their corresponding electronic ~~legal document~~file to be subsequently retrieved.

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8. (Amended) The method of claim 1 wherein the electronic ~~documents~~files comprise email messages having attachment files, the method further comprising:

separating the attachment files from the email messages;

converting the attachment files into a first format and storing the converted attachment files in the database system; and

converting the email messages into a second format and storing the converted email messages in the database system.

9. (Amended) A method to display stored electronic ~~legal documents~~files, the method comprising:

providing a first field to allow a user to enter search query information directed towards the stored electronic ~~legal documents~~files, wherein the electronic files comprise third-party electronic files;

providing a window to display a representation of an electronic ~~legal document~~file retrieved in response to the entered search query information, the electronic ~~legal document~~file being retrievable by matching the search query information with stored electronic characteristics associated with a native format of the electronic ~~legal documents~~files; and

providing a plurality of second fields to allow the user to enter and save processing information associated with the displayed representation of the electronic ~~legal document~~file.

10. (Amended) The method of claim 9 wherein the electronic ~~legal documents~~files comprise email messages having threading information and wherein matching the search query information with the stored electronic characteristics comprises providing search results including threading information of email messages.

11. (Amended) The method of claim 9, further comprising:

providing summary fields having summary information associated with the stored electronic ~~legal documents~~files; and

providing the summary fields with links that, if activated, trigger a display of representations of electronic ~~legal documents~~files corresponding to the activated links.

12. (Amended) The method of claim 9, further comprising:

providing search result fields having search result information associated with the search query information; and

providing the search result fields with links that, if activated, trigger a display of representations of electronic ~~legal documents~~files corresponding to the activated links.

13. (Amended) A method, comprising:

recursively extracting a plurality of third-party electronic ~~documents provided from a source~~files, each of the electronic ~~documents~~files having electronic characteristics that are associated with a native format of the electronic ~~document~~file and that uniquely identify the electronic ~~documents~~files from each other;

for each of the extracted electronic ~~documents~~files, identifying a plurality of objects having different data formats, one of the identified objects corresponding to the electronic characteristics;

storing data associated with the one of the identified objects in a first location in a database system;

converting the other identified objects and storing data associated with the converted objects in a second location in the database system; and

indexing the data stored in the first and second locations.

14. (Amended) The method of claim 13 wherein recursively extracting the plurality of third-party electronic ~~documents~~files comprises extracting third-party electronic ~~documents~~files located in a plurality of paths in a directory structure.

15. (Amended) The method of claim 13 wherein the electronic ~~documents~~files comprise email messages and the electronic characteristics comprise metadata, the metadata including threading information.

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16.   (Amended)   The method of claim 13 wherein the electronic ~~documents~~files comprise email messages having attachment files, the method further comprising:

separating the attachment files from the email messages;

converting the attachment files into a first format and storing the converted attachment files in the database system; and

converting the email messages into a second format and storing the converted email messages in the database system.

17.   (Amended) A network node, comprising:

a server communicatively coupled to a database system, the database system having stored and indexed therein third-party electronic ~~documents~~files and electronic characteristics associated with a native format of the electronic ~~documents~~files, the server responsive to a search query ~~transmitted from a user node~~ to search the database system for electronic ~~documents~~files matching the search query, the server being ~~capable of using~~configured to use indexing information and the stored electronic characteristics to provide search results ~~to the user node~~ that are responsive to the search query.

18.   (Amended) The network node of claim 17 wherein the server stores user-input information associated with representations of electronic ~~documents provided to the user node~~files, the user-input information being stored by the server in the database system and being retrievable by the server in response to subsequent search queries ~~transmitted from the user node~~.

19.   (Amended)   The network node of claim 17 wherein the electronic ~~documents~~files comprise email messages having threading information, the electronic characteristics of the electronic ~~documents~~files including the threading information, the server being configured to provide the search results ~~capable of being provided~~ to the user node along with email messages and their corresponding threading information.

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20. (Amended) A system, comprising:

a conversion engine to convert third-party electronic ~~legal documents~~files into a database format, the conversion engine being configured to identify electronic characteristics associated with a native format of the electronic ~~legal documents~~files; and

a server coupleable to the conversion engine and communicatively coupled to a database system, the database system having stored and indexed therein the third-party electronic ~~legal documents~~files converted by the conversion engine and the electronic characteristics identified by the conversion engine, wherein the server ~~capable of being~~is responsive to a search query ~~transmitted from a user node~~ to search the database system for electronic ~~legal documents~~files matching the search query, wherein the server ~~capable of using~~is configured to use the indexing information and the electronic characteristics to provide search results ~~to the user node~~that are responsive to the search query.

21. (Amended) The system of claim 20 wherein the conversion engine is ~~capable of loading~~structured to load the electronic ~~legal documents~~files into the database system, ~~by~~the conversion engine including:

at least one recursive engine to recursively ~~extracting~~extract a plurality of third-party electronic ~~legal documents provided from a source~~files;

at least one controller coupled to the recursive engine to ~~identifying~~identify a plurality of objects having different data formats for each of the extracted electronic ~~legal documents~~files, one of the identified objects corresponding to the electronic characteristics;

~~storing~~an upload unit coupled to the controller to store data associated with the one of the identified objects in a first location in the database system; and

~~converting~~at least one converter coupled to the controller to convert the other identified objects and ~~storing~~to store text data associated with the converted objects in a second location in the database system, wherein~~; and~~

~~indexing~~the data stored in the first and second locations are indexed.

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22. (Amended) The system of claim 20 wherein the server comprises:

a first server unit to store indexing information associated with text content of the electronic ~~legal documents~~files; and

a second server unit to store indexing information associated with metadata content of the electronic ~~legal documents~~files.

23. (Amended) A machine-readable medium containing a data structure of <u>third-party</u> electronic ~~legal document~~file information comprising a plurality of first tables having indexing information associated with a text content of<u> third-party</u> electronic ~~legal documents~~files, a second plurality of tables having indexing information associated with metadata content of the electronic ~~legal documents~~files, the indexing information in the second tables corresponding to electronic characteristics associated with a native format of the electronic ~~legal documents~~files.

24. (Amended) The machine-readable medium of claim 23, further comprising a third plurality of tables having a substantially native display format of the electronic ~~legal documents~~files.

25. (Amended) The machine-readable medium of claim 23 wherein the second plurality of tables includes fields to store user-input information associated with representations of electronic ~~legal documents~~files processed by a user.

26. (Amended) The machine-readable medium of claim 23 wherein the second plurality of tables further have indexing information associated with attachment files of the electronic ~~legal documents~~files.

27. (Amended) The machine-readable medium of claim 23 wherein the electronic ~~legal documents~~files comprise email messages having metadata information, the second plurality of tables having indexing information corresponding to the metadata

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information, the metadata information useable to relate threading information of the electronic ~~legal documents~~files.

28. (Amended) A machine-readable medium having stored therein instructions, which when executed by a processor, cause the processor to perform the following, comprising:

provide access to ~~indexed~~third-party electronic ~~legal documents~~files stored in a database system, the stored electronic ~~legal documents~~files being stored and indexed in the database system along with electronic characteristics associated with the native format of the electronic ~~legal documents~~files; and

if user-input information is received, process the indexed third-party electronic ~~legal documents~~files according to the received user-input information and by using the stored electronic characteristics.

29. (Amended) The machine-readable medium of claim 28 wherein the processor further performs the following, comprising:

if user-input information including a text content search query is received, search the stored electronic ~~legal documents~~files using indexing information associated with textual content of the stored electronic ~~legal documents~~files; and

if user-input information including a metadata search query is received, search the stored electronic ~~legal documents~~files using indexing information associated with metadata content of the stored electronic ~~legal documents~~files.

30. (Amended) The machine-readable medium of claim 28 wherein the stored electronic ~~legal documents~~files comprise email messages and wherein the processor searches for individual email messages based on user-input information including a search query of metadata content or text content of the email messages.

33. (Amended) The network node of claim 17 wherein the electronic ~~documents~~files comprise electronic legal documents.

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34.   (Amended)   The method of claim 13 wherein the electronic ~~documents~~files comprise electronic legal documents.

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